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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,529	11/15/2001	Yasuhiro Hino	35.C15947	7272
5514	7590	01/30/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			KANG, ROBERT N	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 01/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/987,529	HINO, YASUHIRO	
	<b>Examiner</b>	<b>Art Unit</b>	RNK
	Robert N. Kang	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 December 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 and 35-37 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-32 and 35-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

***Response to Amendment***

***Response to Arguments***

1. Rejections under 35 U.S.C. § 112 have been withdrawn; Examiner had suggested reducing breadth of claims to facilitate expedient allowance.
2. Regarding Applicant's traversal of rejections under 35 U.S.C. 102(e), the rejections have been withdrawn, and claims 1-32 and 35-37 are now rejected under 35 U.S.C. 103(a). Because this modification was made in light of the new claim limitations added by the applicant, this rejection is final.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab (US-PAT 6,029,182).

The Nehab patent anticipates all features of the pending application with the exception of 4 differences cited by the applicant his amendment:

- 1.) "Nehab fails to disclose sending acquisition information for acquiring data and layout information necessary for assigning an image to an external apparatus or acquiring data for output from the external apparatus, as is recited in independent Claims 1, 10, 17, and 35... Nehab does not send the layout information to an external apparatus."

- 2.) "Nehab fails to disclose sending layout information to an external apparatus to cause the external apparatus to generate data for output based on the sent layout information, and acquiring the data for output generated by the external apparatus, as recited in independent claims 11, 14, 26, 29, 36, and 37."
- 3.) Nehab does not disclose "changing the received layout information as recited in independent claims 11, 26, and 36."
- 4.) Nehab does not disclose "determining layout information if the received print instruction does not include any layout information, as is recited in independent claims 14, 29, and 37."

Therefore, were Nehab modified in a way such that these four limitations were met; Examiner asserts that all dependent claims would also be therefore unpatentable.

Client/Server interactions were well known at the time of invention to those of normal skill in the art (Official Notice). The motivation of the client/server system architecture is obvious, to provide central hardware/software for the execution of programs or applications throughout a distributed system without the added costs and complexity of providing application-specific hardware and/or software to every client host machine in a network.

Ergo, it would have been obvious at the time of invention to those of normal skill in the art to implement Nehab's invention as a server. The most logical method of implementation allows flexibility in defining user parameters on a local machine and sending said profiles to a server. This is most obviously achieved by drawing a horizontal line on figure 6 between the web printer 17 and the site profile 20 and

personal news profile 19 (these are embodied within the personal news profile editor application 16). Obviously, this horizontal line represents a network connection between the host machine containing elements 19 and 20, and the web printer 17. Therefore, the output interface 40 would go through the network interface back to the host computer, as defined by well-established network architecture in the field of client/server interactions. Therefore, the server including the web printer 17, site driver 51, web reader interface 50, and web reader 34 now qualifies as the "external apparatus."

In regards to argument 1, because the personal-news-profile 19 contains format information in a template, the "image forming apparatus," comprising the host machine and the printer, sends acquisition information for acquiring data and layout information necessary for assigning an image to an external apparatus or acquiring data for output from the external apparatus."

Regarding argument 2, referencing figures 7 and 8, the "external apparatus," after receiving the personal news profile 19 in step S701, retrieves the data via the web reader in S704, and formats the linear document according to the template stored in personal news profile in S802. The formatted newspaper is then sent out the output interface in S803, which, in light of the modification, sends back to the host PC. Therefore, the modified Nehab invention "sends layout information to an external apparatus to cause the external apparatus to generate data for output based on the sent layout information, and acquires the data for output generated by the external apparatus."

With regards to argument 3, Nehab states in column 8, lines 27-28, "In step S500 of FIG 5A, a personal-news-profile editor 16 is launched by a user." The personal-news-profile 16 comprises layout and acquisition information, which is gathered for the first time from a user in steps S505-S510. Therefore, the image forming apparatus's "reception means" is the graphical user interface between the user and the application as shown in figures 9a-9e and as described by Nehab in column 9, lines 36-38, "personal-news-profile editor 16 may be invoked as a graphical user interface which allows a user to edit a previously stored personal-news-profile."

The layout editor 39 functions as a "changing means for changing the layout information received by the reception means" from the user. Nehab states in column 10, lines 12-14, that the "layout editor 39 is capable of determining the types of fonts and colors available to the user based on the system's printer capabilities." Therefore layout information received in the form of the personal-news-profile 19 from the user is changed by the layout editor 39, which is in turn sent to the external apparatus "so as to cause the external apparatus to generate data for output based on the sent layout information."

Finally, regarding argument 4, Nehab discloses in column 6, lines 63-65, a formatter 42 implemented within the web printer 17 which formats the linear document "according to user-specified (or default) formatting instructions into formatted document 33." This default formatting instruction is utilized when a user template is not defined as shown in appendix 2, column 22, line 30. The default format is determined by the format editor 39 shown in figure 4. Therefore, the if personal new profile 19 does not

include any layout information, the format editor 39 in personal news profile editor 16, stored in the image forming apparatus, sets a default format and sends the request to the external apparatus. Therefore, the "image forming apparatus comprises ... a determination unit adapted to determine layout information required for assigning an image based on data to the recording medium, if the received printinstruction does not include any layout information for the data."

Thus, the Nehab invention in a server configuration meets all of the asserted novelties of the pending application, "without departing from the spirit and scope of the appreciated claims," as stated by Nehab in column 19, lines 55-60, through a minor modification of system architecture.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

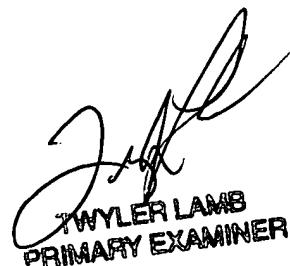
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is (571) 272-0593. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RNK



TWYLER LAMB  
PRIMARY EXAMINER